



Docket No.: O3020.0288/P288
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Nobuaki Omata, et al.

Application No.: 10/032,463

Confirmation No.: 6604

Filed: January 2, 2002

Art Unit: 2834

For: ACTUATOR AND METHOD OF
MANUFACTURING A STRAIN
ELEMENT

Examiner: T. Dougherty

**COMMENTS ON EXAMINER'S STATEMENTS
OF REASONS FOR ALLOWANCE**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicants have reviewed the Examiner's Statements of Reasons for Allowance and submit the following comments. In an Office Action mailed January 30, 2003, the Examiner provided reasons for allowance of claims 3-5, 7 and 8. The reasons state that the prior art fails to teach or suggest "the thickness dimension requirements of the elemental parts of the invention." The Applicants wish to point out that the claims do not recite a "thickness dimension." Rather, claims 3-5 recite relative widths of certain elements, and claims 7 and 8 recite relative heights of certain elements.

The January 30, 2003, reasons also state that the prior art does not teach or suggest electrodes "on opposing sides of the coil and neither electrode covers the entire surface on which it resides, while it is placed on a linear end surface opposite to the surface of the electrode on the opposing side." Applicants wish to point out that while claims 3, 4 and 7 recite limitations that are generally similar to the Examiner's language quoted above,

the Applicants do not acquiesce to any language or terms that do not exactly correspond to the limitations recited in the claims. Further, claims 5 and 8 do not recite the Examiner's language quoted above.

In an Office Action mailed July 24, 2003, the Examiner provided a statement of reasons for allowance of claims 1-5, 7, 8, 12-17 and 26. The reasons state that a "coiled dielectric or metallic band with a dielectric upon it, wherein electrodes do not cover the entire surface of the dielectric from top to bottom are not found in the prior art." Applicants wish to point out that none of the allowed claims recite that "electrodes do not cover the entire surface of the dielectric from top to bottom." Further, the Applicants do not acquiesce to any language or terms that do not exactly correspond to the limitations recited in the claims.

The July 24, 2003, reasons also state that a "dielectric that does not cover the surface of said metallic band but fails to extend from top to bottom of ... it" is not found in the prior art. The Applicants wish to point out that none of allowed claims recite this limitation. Finally, the July 24, 2003, reasons state that a "dielectric coil with electrodes on its surfaces which further includes a separate capacitor formed on and by the dielectric" is not found in the prior art. Applicants wish to point out that only claims 14, 15, 17/14, 17/15, and 26 recite a capacitor. Also, the Applicants do not acquiesce to any language or terms that do not exactly correspond to the limitations recited in the claims.

Otherwise, the Applicants agree with the Examiner that the prior art fails to teach or suggest the invention as defined in the allowed claims. The independent claims recite additional limitations which distinguish the claims over the prior art. Also, the dependent claims recite limitations which, in combination with their base claims, render the dependent claims allowable over the prior art.

Dated: January 5, 2004

Respectfully submitted,

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